

REMARKS

The Office Action mailed September 16, 2008 (hereinafter, "Office Action") has been reviewed and the Examiner's comments considered. Claims 23, 24, 33, 34, 37, 38, and 41-43 are pending in this application. No amendments are made herein. Applicants thank the Examiner for the telephonic interview held January 28, 2009, in which the cited references were discussed in view of the pending claims.

Statement on Substance of Interview

The interview was conducted via telephone on January 28, 2009, between the undersigned, Ms. Kari Barnes, Examiner Melissa Ryckman, and Supervisor Jackie Ho. Independent claims 23 and 41 were discussed in view of the outstanding restriction requirement and the rejection of the claims under 35 U.S.C. § 103 as obvious over USPN 4,198,960 to Utsugi (hereinafter, "Utsugi") in view of USPN 5,163,942 to Rydell (hereinafter, "Rydell"). Applicants argued that the combination of Utsugi/Rydell failed to establish a *prima facie* case of obviousness, in particular with respect to the combination of the first and second operating members and the first and second gear racks. The Supervisor indicated initially that the combination of operating members and gear racks, as recited in independent claim 41, were not shown by the cited combination and the Examiner agreed to update the search following the receipt of this Response. Applicants have chosen to postpone making claim amendments, if any, pending the results of the updated search.

Claim Restriction

Claims 41-43 were indicated as withdrawn from consideration as being directed to a non-elected invention. However, as agreed during the interview held January 28, 2009, claims 41-43 are directed to the same invention as originally claimed. Therefore, the Examiner is respectfully requested to withdraw the restriction requirement and reconsider claims 41-43.

Claim Rejections - 35 U.S.C. § 103

Claims 23, 24, 34, and 38 stand rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 4,198,960 to Utsugi (hereinafter, "Utsugi") in view of USPN 5,163,942 to Rydell (hereinafter, "Rydell"). Applicants respectfully traverse this rejection.

Independent claim 23 recites, *inter alia*, “a first operating member,” “a second operating member,” and “a three-dimensional basket having at least three legs,” where “the proximal end of a first and second legs being connected to the distal end of the first operating member, and the proximal end of a third leg being connected to the distal end of the second operating member.”

Applicants submit that the asserted combination does not establish a *prima facie* case of obviousness at least because not all of the claimed limitations are taught or suggested by the cited art. (*In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)). In particular, neither Utsugi nor Rydell shows or describes at least the first and second operating member.

The Office Action asserts that Utsugi discloses the three dimensional basket having at least three legs with operating members by quoting Utsugi at column 4, lines 36-43: “the trapping wires 33 are individually operated.” Applicants respectfully submit that the Office Action misinterpreted the Utsugi reference at least with respect to its showing the first operating member connected to a first and second legs and a second operating member connected to a third leg. The quoted citation in the Office Action actually appears to undermine the allegation.

Indeed, Utsugi shows and describes *individual* trapping wires that are *individually* operated. (Utsugi, col. 2, ll. 17-21, col. 4, ll. 36-43). In fact, Utsugi requires that each of the individual trapping wires remain separate, by passing each through a separate bore in the top of the sheath. (Utsugi, col. 3, ll. 32-34, “front ends 33a of elastic and flexible trapping wires 33 pass through the small bores 32a, 32e, 32g, 32i, and 32k, respectively”). Further, Utsugi teaches that the individual operation of the wires is required to properly operate the device:

At least three flexing wires 37 extend through the lateral wall 32 of the sheath 30 and they are arranged at substantially equal intervals along the circumference of the sheath 30. . . . [T]he flexing portion 30a can be freely bent by pulling only said one wire 37. Generally, however, there is little possibility that said one wire 37 is disposed in said [proper orientation]. In this case, a pair of flexing wires 37, which are disposed opposite to each other . . . are properly pulled. The resultant force produced by the paired wires 37 bends the

flexing portion 30a of the sheath 30 in the required direction to a required extent.

(Utsugi, col. 5, l. 67 – col. 6, l. 17).

The Office Action also asserts that Rydell teaches a first operating member and a second operating member. However, Rydell shows and describes a belt or cable that forms a single loop. (Rydell, col. 3, ll. 15-16). Therefore, Rydell does not suggest an operating member coupled to more than one leg of a basket.

Accordingly, Applicants respectfully submit that the combination of Utsugi and Rydell does not form the basis of a *prima facie* case of obviousness at least due to the fact that neither reference shows a first and second operating member.

Further, one skilled in the art would not look to modify Utsugi in view of Rydell. The Office asserts that it would have been obvious to one of ordinary skill in the art to combine Utsugi and Rydell as having a wheel for an actuator and a slide for a second actuator as they are commonly known actuators in the art, and are useful in maneuvering objects. However, as discussed above, Utsugi's invention requires the individual operation of the trapping wires. (Utsugi, col. 2, ll.16-20). The individual operation of the trapping wires permits adjacent trapping wires to separate in order to trap a stone. (Utsugi, col. 4, ll. 36-41). Further, the operation of a single trapping wire or different trapping wires assures free adjustment of the sheath to permit positive insertion of the sheath into a small duct or tract. (Utsugi, col. 3, ll. 62-65). Therefore, Utsugi cannot be modified to include operating members coupled to more than one leg. Even if the actuators of Rydell were combined with Utsugi, according to the teaching of Utsugi, it would merely provide an alternate way of individually operating each trapping wire. Therefore, a slide or rotating actuator would be coupled to each trapping wire. The resulting large and bulky device would ultimately defeat the purpose of Utsugi to remove foreign matter from a body cavity, as the device would be too large and cumbersome to operate within body vessels and cavities.

As set forth in MPEP § 2143(A), “[t]he rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no

change in their respective functions, and the combination yielded nothing more than predictable results to one of ordinary skill in the art.” (underlining added for emphasis). MPEP § 2143(A), p. 2100-129, Eighth Edition, Rev. 6, Sept. 2007. Further, as set forth in MPEP § 2143.01, under *KSR*, “[i]f the proposed modification or combination of prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” MPEP § 2143.01, p. 2100-141, Eighth Edition, Rev. 6, Sept. 2007.

In view of the above, Applicants respectfully submit that a *prima facie* case of obviousness has not been established at least because all of the claim limitations are not taught or suggested by the cited combination of references (MPEP § 2143), and further because the combination of Utsugi and Rydell cannot properly be combined. Accordingly, for at least these reasons, independent claim 23 is patentable over the cited combination. Claims 24 and 37-38 are patentable because they depend from a patentable independent claim, and also because they recite features not shown or described by the cited art. Therefore, Applicants request favorable reconsideration and withdrawal of the rejections under 35 U.S.C. § 103.

Claim 33 stands rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Utsugi and Rydell and further in view of USPAPN 2002/0019594 to McClellan, et al. (hereinafter, “McClellan”). Claim 34 stands rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Utsugi and Rydell and further in view of USPN 6,527,781 to Bates (hereinafter, “Bates”). Applicants respectfully traverse this rejection.

In view of the above, without conceding the propriety of the asserted combination or the allegations in the Office Action, Applicants submit that claims 33 and 34 are patentable at least because they depend from independent claim 23. Moreover, neither McClellan nor Bates show or describe the claimed features missing from the combination of Utsugi and Rydell. Accordingly, Applicant respectfully requests favorable reconsideration and withdrawal of the rejections under 35 U.S.C. § 103.

With respect to independent claim 41, and dependent claims 42-43, Applicants submit that each is patentable over the asserted combinations in view of the January 28, 2009

interview summarized above, and for the reasons as stated above with respect to independent claim 23.

CONCLUSION

Each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

It is noted that the remarks herein do not constitute, nor are they intended to be, an exhaustive enumeration of the distinctions between the cited references and the claimed invention. Rather, the distinctions identified and discussed herein are presented solely by way of example. Consistent with the foregoing, the discussion herein should not be construed to prejudice or foreclose future consideration by Applicants of additional or alternative distinctions between the claims of the present application and the references cited by the Examiner and/or the merits of additional or alternative arguments.

In the event the U.S. Patent and Trademark Office determines that an extension and/or other relief is required, Applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. **50-2191** referencing docket no. 1016740027P2. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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Respectfully submitted,

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